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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,730	06/12/2001	Kenji Nagoya	B422-161	4879

26272 7590 04/26/2005

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EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

3625

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,730

Applicant(s)

NAGOYA ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10,12-18,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10,12-18,20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment received on 12/20/2004 is acknowledged and entered. The applicant has amended claims 1, 3-7, 9, 12, 14-18, and 20 and canceled claims 8, 11, 19 and 22. Currently claims 1-7, 9-10, 12-18, 20-21 are pending for examination. The applicant has also amended the specification on page 46, lines 2-5 and the same is also acknowledged and entered.

Response to Arguments

- 2.1. Since the applicant has amended claims 3, and 14 claim objections are withdrawn.
- 2.2. Since claims 8, 11, 19 and 22 have been canceled the rejection of these claims under USC 35 112, second paragraph are withdrawn.
- 2.3. Applicant's arguments, see Remarks, pages 7-11, filed on 12/20/2004, with respect to rejection of claims 1-22 under 35 USC 103 (a) as being unpatentable in view of Official Notice have been fully considered and are persuasive and accordingly this rejection is withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the reference.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3.1. Claims 12-18, and 20-21 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non-statutory subject matter.

35 U.S.C. §101 requires that in order to be patentable the invention must be a “new and useful process, machine, manufacture or composition of matter or new and useful improvement thereof” (emphasis added). Applicant’s claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. The claim begins by discussing an article, that is a storage medium (see the Preamble of claim 12), whereas the body of the claim discusses the specifics of the process steps that is the steps of creating and calculating. “A claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only”, Ex parte Lyell (17USPQ2d 1548). Since claims 13-18 and 20-21 are dependencies of the claim 12 they will also inherit the same deficiency and are therefore rejected.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.1. Claims 12-18 and 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to an article, that is a storage medium, but the body of the claim discusses the specifics of the process steps of creating and calculating. Claims 13-18 and 20-21 are rejected as being dependent on claim 12 as discussed above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9, 12-18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Arledge, Jr. et al. (US Patent 6,535,294-this reference was cited in Form 892 sent in the earlier Office action), hereinafter referred to Arledge.

5.1. Regarding claims 1-3, Arledge discloses an information processing apparatus capable of printing data by using another apparatus connected to a network (see at least FIGs.1-3 and col.7, line 30-col.11, line 65. The wholesale web server 140 corresponds to an information processing apparatus capable of printing data by using

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another apparatus, that is "280" the workflow management server computer connected to a network.), comprising:

creating means for creating setting information to print data, during a predetermined process of making a print data recognizable by the other apparatus in accordance with a print instruction by a user (see at least Figs 1-3, col.10, lines 11-28 and col.15. line 55-col.16, line 43. Preparations system "201", see Fig.3 is the creating means for creating setting information to print data and this print data is recognizable by the other apparatus, that is "200" the workflow management server computer. The predetermined process of making print data is disclosed in col.15, line 55-col.16, line 43 on the instructions of an end-user); and calculating means for calculating a print charge in accordance with the created setting information, wherein creating the setting information and calculating the print charge are performed before the printdata is sent to the network (see at least, Fig.2, and col.17, lines 1-16, where the reference " 241" corresponds to the calculating means. The calculating means calculates the print charge before it is sent to the network to "200" the workflow management server computer for printing and displays the billing, that is printdata charges to the user to enable him to decide to place or cancel the order). See col.8, line 63-col.11, line 65 and Figs. 2 and 3 which discloses that the calculating, and creating the setting information are done by a control program, that "201-the information products preparation system" for controlling the other apparatus, and further the programs which create setting information and calculate price are different programs.).

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5.2. Regarding claims 4-7, and 9, Arledge discloses the limitations of settling beforehand before performing the calculation and sending the print data to the network, the print data is not sent to the network if the charge exceeds a predetermined value, notifying the user of print charges, for terminating a print process in response to an operation by the buyer, calculates the print charge in accordance with charge information stored in the information processing apparatus (see at least col.8, line 63-col.10, line 28 and col.17, lines 1-16 which discloses that the charges for the customized print data on the instructions of the user are calculated before sending the print data to the network, that is the workflow management server for printing so that the customer can accept or reject the charges and if the customer rejects the charges, for the probable reasons that they exceed than his expectations then the print job is terminated and the user is sent back to previous screen).

5.3. Regarding claims 12-18 and 20, there limitations are closely parallel to the limitations of claims 1-7 and 9 and are therefore analyzed and rejected on the same basis.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Arledge and further in view of an Official Notice.

6.1. Regarding claim 10, Arledge discloses the information processing apparatus and a program for calculating the print charges of the customized print data as per the instructions of an user as analyzed above for claim 9. Arledge does not explicitly state that the charge information is updated. However, the examiner takes an Official Notice of the fact and benefits of updating any stored information for the obvious reason of being able to know the prevailing rates for any job/services and submit the realistic price quote/information to the buyer. In view of the Official Notice it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Arledge to incorporate the feature of updating the information related to vendors, their bids, etc which is related to charge information for the print jobs because it would enable the system to calculate the price bid for print jobs requested by the user based on latest vendor prices rather than obsolete and old stored prices and avoid the waste of time and money which will result by considering obsolete vendor data/prices.

6.2. Regarding claim 21 its limitations are closely parallel to the limitations of claim 10 and is therefore analyzed and rejected on the same basis.

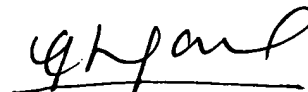
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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
April 18, 2005